

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

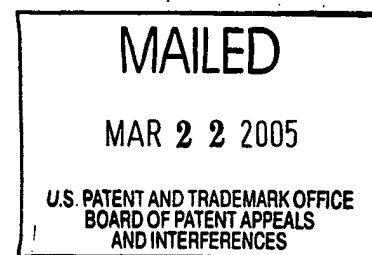
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARIO FRYBERG, STEFAN SCHUTTEL and HIROSHI TOMIMASU

Appeal No. 2004-1906
Application 09/040,825

ON BRIEF



Before WALTZ, KRATZ, and JEFFREY T. SMITH, Administrative Patent Judges.

WALTZ, Administrative Patent Judge.

REQUEST FOR REHEARING

Pursuant to the provisions of 37 CFR § 41.52(a)(1) (effective Sep. 13, 2004; 69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat. Office 21 (Sep. 7, 2004)), appellants have submitted a Request for Rehearing (hereafter "Request") of our Decision dated

Sep. 20, 2004, affirming the examiner's rejection of claims 3, 4 and 6 through 13 under 35 U.S.C. § 103(a) over Kono in view of Smigo (Decision, pages 3 and 11; Request, page 2).¹

Appellants request rehearing based on three issues. Specifically, appellants first assert that the Board incorrectly selected and reviewed only independent claim 12, and did not consider independent claim 13 (Request, page 2). Appellants argue that the Board should have considered independent claim 13 as appellants provided support that the rejected claims "do not stand or fall together" (Request, page 3).

This argument is not persuasive. As stated in our Decision, this merits panel of the Board recognized that appellants consider that "the claims on appeal do not stand or fall together" (Decision, page 2). However, this is but one requirement appellants had to satisfy to have any claims separately considered. As correctly noted by the examiner (Answer, page 3, ¶(7)) and our Decision (page 2), the second requirement is that appellants must provide arguments or explanations on why the groups of claims are considered separately patentable. See 37 CFR § 1.192(c)(7)(8)(1995);

¹The other rejection on appeal was reversed (Decision, page 5).

Ex parte Schier, 21 USPQ2d 1016, 1018 (Bd. Pat. App. & Int. 1991). As stated by our reviewing court in *In re McDaniel* (Decision, page 2):

If the brief fails to meet either requirement [of 37 CFR § 1.192(c)(7)], the Board is free to select a single claim from each group of claims subject to a common ground of rejection as representative of all claims in that group and to decide the appeal of that rejection based solely on the selected representative claim.

Secondly, appellants argue that the Board incorrectly applied the catPVA range of Kono as being 75 to 99% by weight, which is a range beyond the teaching of its examples (Request, page 3). Appellants further argue that Kono provides "insufficient disclosure" for teaching a range of 75 to 99% by weight (Request, page 4).

These arguments are also not persuasive. As set forth in the Decision (page 7), the disclosure of Kono is not limited to its examples. See *In re Mills*, 470 F.2d 649, 651, 176 USPQ 196, 198 (CCPA 1972); *In re Widmer*, 353 F.2d 752, 757, 147 USPQ 518, 523 (CCPA 1965). With regard to appellants' argument that Kono provides "insufficient disclosure" for the broad range of 75 to 99% by weight, we note that this argument was not presented prior to this Request. Accordingly, this argument is considered waived. See *In re Kroekel*, 803 F.2d 705, 709, 231 USPQ 640, 642-

43 (Fed. Cir. 1986); and 37 CFR § 41.52(a)(1)(2004).

Furthermore, any argument concerning the "insufficient disclosure" or enablement of a U.S. Patent must be more than mere attorney argument. See *In re Sasse*, 629 F.2d 675, 681, 207 USPQ 107, 111 (CCPA 1980).

Thirdly, appellants argue that the Board unintentionally mislead and misapplied a statement that Kono discloses the same binder system as preferred by appellants (Request, page 4). Appellants further argue that the binder system of claim 13 differs from the binder system of Kono (*id.*).

These arguments are not persuasive. First, as previously discussed, we limit our consideration in this appeal to claim 12, and thus any argument concerning claim 13 must be considered as a new argument. See *In re Kroekel*, *supra*; 37 CFR § 41.52(a)(1)(2004). Furthermore, we note that appellants' arguments regarding a "**single** binder" are not commensurate with the scope of the claims, since claim 12 merely requires "a binder or mixture of binders" and claim 13 requires "a binder comprised of gelatin." Appellants admit that Kono teaches use of a gelatin binder (Request, page 4). We note that "comprised" as used in claim 13 opens the claim to include at least gelatin but also any other ingredient or binder. See *Exxon Chemical Patents Inc. v.*

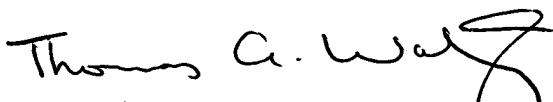
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Lubrizol Corp., 64 F.3d 1553, 1555, 35 USPQ2d 1801, 1802 (Fed. Cir. 1995); and *In re Baxter*, 656 F.2d 679, 686-87, 210 USPQ 795, 802-03 (CCPA 1981).


We do not find in the Request any argument convincing us of error in the conclusion we reached in our Decision. Accordingly, appellants' Request for Rehearing is denied.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv) (effective Sep. 13, 2004; 69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat. Office 21 (Sep. 7, 2004)).

DENIED


THOMAS A. WALTZ
Administrative Patent Judge)


PETER F. KRATZ
Administrative Patent Judge)


JEFFREY T. SMITH
Administrative Patent Judge)

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